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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,411	10/16/2001	George H. Kitchen III	70008-9101	5840
5179	7590	05/02/2005	EXAMINER	
PEACOCK MYERS AND ADAMS P C			TOOMER, CEPHIA D	
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ALBUQUERQUE, NM 871256927			PAPER NUMBER	

1714

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,411

Applicant(s)

KITCHEN ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 172-343 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 172-343 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed February 7, 2005 in which claims 67-171 were canceled and claims 172-343 were added.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 192, 201, 208, 231, 252, 265, 285, 299 and their dependents (claims 192-316) are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The specification discloses that fuel additives of the current invention comprise a stabilizer (fuel stabilizer) and an organometallic compound and that these components are critical or essential to the practice of the invention, but the stabilizer is not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant discloses that these components are always present in the fuel composition. Therefore, by not including the stabilizer in the independent claims, it appears that Applicant is setting forth no criticality in the use of the stabilizer.
3. Claims 176 and 184 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The original specification does not support said fuel composition having a total part by weight of 1.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The following claims and their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 172 is rejected because the terms "high molecular weight" is indefinite.

The term high is a relative term that does not have a comparative value.

Claim 173 is rejected because there is no antecedent support in claim 173 for an amine containing more than 14 carbon atoms.

Claim 175 contains the trademark/trade name Primene® RB-3. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fuel stabilizer and, accordingly, the identification/description is indefinite.

Claim 179 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 183 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 187 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 191 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 192 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 193 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 194 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 201 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 203 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 209 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 217 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 221 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 227 is rejected because there is no antecedent support in claim 208 for "said solvent."

Claim 228 contains the trademark/trade name Consolve® C-145. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe naphtha and, accordingly, the identification/description is indefinite.

Claim 232 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 237 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 242 contains the trademark/trade name Consolve® C-145. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App.

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1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe naphtha and, accordingly, the identification/description is indefinite.

Claim 242 is rejected because there is no antecedent support in claim 231 for "said fuel stabilizer."

Claim 244 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 248 contains the trademark/trade name Vancide®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide and, accordingly, the identification/description is indefinite.

Claim 259 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 263 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 266 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 267 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 270 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 272 contains the trademark/trade name Consolve® C-145. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe naphtha and, accordingly, the identification/description is indefinite.

Claim 275 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 284 is not further limiting because claim 265 already recites up to 0.2 parts by weight of the metal deactivator.

Claims 285 and 286 are rejected because the term "high" is a relative term that does not have a comparative value.

Claim 293 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 300 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 301 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 304 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 306 contains the trademark/trade name Consolve® C-145. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe naphtha and, accordingly, the identification/description is indefinite.

Claim 309 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim 317 is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 321 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim ~~334~~³³ is rejected because the term "high" is a relative term that does not have a comparative value.

Claim 335 is rejected because there is no antecedent support in claim 330 for "said solvent".

Claim 336 contains the trademark/trade name Consolve® C-145. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe naphtha and, accordingly, the identification/description is indefinite.

Claim 339 is rejected because the term "low" is a relative term that does not have a comparative value.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 184, 185, 189, 252, 255, 256, 257, 258, 265, 268, 269, 279, 280, 284, and 330-333 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croudace (US 4,444,565).

Croudace teaches a fuel additive concentrate comprising dicyclopentadienyl iron (see abstract). The additive concentrate contains 1-50 grams per gallon and a diluent (see col. 3, lines 58-68). The iron content of the fuel is between 0.0001 and 10 grams per gallon of fuel (see col. 4, lines 60-64; col. 5, lines 20-36). The fuel may contain conventional stabilizing additives such as antioxidant, metal deactivators and anti-knock agent and manganese methyl cyclopentadienyl tricarbonyl (see col. 5, lines 40-51). The diluents include hydrocarbon solvents (see col. 6, lines 5-14).

Croudace differs from the claims in that he teaches the proportions of the components as grams per gallon whereas the present claims recite the proportions as parts by weight. However, it is the examiner's position that the ranges are close enough that one skilled in the art would reasonably expect that the fuel composition would possess the same properties, absent evidence to the contrary.

8. Claims 253 and 254 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croudace as applied to the claims above, and further in view of Kitchen (US 4,609,379).

Croudace has been discussed above. Croudace fails to teach that the metal deactivator is a propane diamine. However, Kitchen teaches this difference in a fuel additive (see abstract; col. 2, lines 42-44).

It would have been obvious to one of ordinary skill in the art to have selected diamine metal deactivators because Croudace desires conventional deactivators and Kitchen teaches that the propane diamines are conventional metal deactivators.

9. Claims 172, 174, 176-178, 181-186, 189-191, 208-217, 219, 220, 223-226, 252, 255-258, 261-269, 273-276, 279-281, 299-303, 307-310, 313, 315, 316, 330-333, 337-340 and 343 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham.

Cunningham teaches a fuel composition comprising at least one fuel soluble detergent/dispersant (functions as stabilizer and/or dispersant) such as amides or long chain aliphatic hydrocarbons (molecular weight at least 300) having a polyamine attached thereto; at least one cyclopentadienyl complex, preferably iron, and at least one fuel soluble liquid carrier (see abstract; col. 1, lines 50-66; col. 2, lines 12-18, 44-49; col. 3, lines 27-29). Examples of the cyclopentadienyl complex include ferrocene, monomethyl ferrocene and bis(methylcyclopentadienyl) (see col. 10, lines 2-14). The carrier may be PAO, hydrotreated or non-hydrotreated polypropylene or polybutene; mineral oils, esters and mixtures of two or more carriers (see col. 11, lines 24-35). The

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oils have low viscosity indices and viscosities (see col. 11, line 64-67; col. 13, lines 1-54).

Cunningham teaches that the fuel additive contains from 20-500 ppm detergent/dispersant, 0.0078 to about 0.25 grams of metal cyclopentadienyl complex, up to about 5 wt% of antioxidants (additional stabilizer) and metal deactivators (see col. 14, lines 33-39, 48-60). Cunningham teaches the limitations of the claims other than the differences that are discussed below.

Cunningham differs from the claims in that he does not specifically teach the ranges as parts by weight, but instead as grams per gallon and ppm. However, it is the examiner's position that the ranges taught by Cunningham are close enough to those of the present invention that one skilled in the art would expect that the composition of Cunningham would have the same properties, absent evidence to the contrary.

10. Claims 230, 253, 254, 282, 283 and 314 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham as applied to the claims above, and further in view of Kitchen (US 4,609,379).

Cunningham has been discussed above. Cunningham fails to teach that the metal deactivator is a propane diamine. However, Kitchen teaches this difference in a fuel additive (see abstract; col. 2, lines 42-44).

It would have been obvious to one of ordinary skill in the art to have selected diamine metal deactivators because Cunningham desires conventional deactivators and Kitchen teaches that the propane diamines are conventional metal deactivators.

11.

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cepha D. Toomer". The signature is fluid and cursive, with the first name "Cepha" being more prominent.

Cepha D. Toomer
Primary Examiner
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